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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,797	03/09/2001	Jon Marcus Randall Whitten	MS1-768US	8294
22801	7590	11/16/2005	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/802,797	<b>Applicant(s)</b> RANDALL WHITTEN ET AL.	
	<b>Examiner</b> Scott E. Jones	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-18, 20-36, 38-42, 57, 58, 60-67 and 69-71 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 8-17, 36, 38-42 and 61-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 20-35, 57, 58, 60 and 69-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/7/04; 1/26/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS 5/2/05; 8/15/05; 10/4/05</u>       |

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on February 25, 2005 in which applicant elects Group III, claims 18, 20-21, 22-35, 57-58, 60, and 69-71, and responds to the claim rejections. Claims 1-6, 8-18, 20-36, 38-42, 57-58, 60-67, and 69-71 are pending.

### ***Election/Restrictions***

2. Applicant's election without traverse of Group III in the reply filed on February 25, 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18, 20-25, 27-35, 57, 58, 60, and 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. 6,599,194) in view of Microsoft®Windows98.

Smith et al. discloses a home video game console system that is modified to include additional communication and storage capability via a modem and hard disk drive. Additionally, Smith et al. discloses it is contemplated that the enhanced video game console system may alternatively be packaged in a common integrated housing and sold as a single unit. Smith et al. discloses:

Regarding Claims 22, 25, and 57:

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- A game console (52) comprising a hard disk drive (206) that is non-removable from the game console and that stores a console application (file(s)) to which the game console boots that presents a graphical user interface providing navigation to media on the game console, wherein the hard disk drive is segregated into a user data region and an application data region (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22).

Regarding Claim 58:

- including a portable media drive (CD ROM) coupled to a processor and configured to communicate with a storage disc upon which the media is stored (Column 4, lines 23-25).

Regarding Claims 20-24 and 28-31:

- the non-removable hard disk drive is configured to store data associated with multiple saved games (Column 7, lines 34-42).

Regarding Claim 60:

- the game console comprising an enclosure for the processor (100), the non-removable hard disk drive (206) and a port (80a-d) for interfacing with a game controller (56a-d) (Column 3, lines 41-46 and Figure 1A).

Regarding Claims 18 and 57:

- A game console (52) comprising a processor (100) and a hard disk drive (206) coupled to the processor, wherein the hard disk drive stores a console application to which the game console boots, and wherein the hard disk drive (partitioned hard disk drive) stores application data such that data associated with a first application is inaccessible to other applications (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42).

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Regarding Claims 27, 34, and 57:

- identifying a game identifier (file name or program on the hard disk drive) associated with a video game installed in a game console, wherein the game console contains a hard disk drive (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22);
- determining portions of the hard disk drive that are associated with the video game based on the game identifier (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22). Additionally, file names stored in a file manager by name and folder/directory is inherent to a hard disk drive having file managing capabilities; and
- preventing the video game from accessing portions of the hard disk drive that are not associated with the video game. Game programs inherently contain executable instructions to open/close/use etc. various files stored in memory. Inherently, a game program is only going to request files called by the executable instructions and associated with the video game. Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game. Also, as previously discussed above, the hard disk drive (206) is partitioned for different kinds of data.

Regarding Claim 35:

- one or more computer-readable media (hard disk drive 206 or CD ROM) comprising computer-executable instructions that, when executed, perform the method as recited in claim 27 (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22).

Regarding Claim 69:

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- an input port for receiving input from a controller (80a-d) operable by a player to generate video game control signals (Column 3, lines 41-46 and Figure 1A);
- an output port (176) for outputting a display of three-dimensional video game play graphics for a television (Audio/Video Out, Figure 1C, Figure 3);
- a processor (100) for executing instructions of a video game program (Figure 2);
- a controller system (56a-d) coupled to said input port (80a-d) and to said processor (100) for executing commands related to the video game control signals (Figures 1A and 2);
- a portable media reader (CD ROM ) for optically reading media to be executed by the processor so as to output to the output port a display of graphics in accordance with the media (Column 4, lines 23-25); and
- a fixed disk in a non-removable hard disk drive (206) in communication with the processor, the fixed disk including a boot sector for storing boot instructions to boot the processor to load an initial program (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42), wherein;
- upon booting the processor to load the initial program, the execution of the initial program by the processor outputs to the output port a display of a user interface that provides a prompt for the game console (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42); and
- the processor executes instructions that are read from the selected media (Game CD or game program data downloaded from the Internet) by the portable media reader (Column 4, lines 23-25).

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Regarding Claim 70:

- the processor will not boot without initially loading the initial program read from the fixed disk by the hard disk drive (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42). Inherently, the system has a boot sequence that requires that a program be read. In this case, that file can be located directly on the hard drive (Column 3, lines 53-56); and
- the initial program is initially loaded from the hard disk drive upon booting the processor such that, prior to the portable media reader reading media containing video game instructions, a display containing the prompt is output to the output port (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42).

Regarding Claim 71:

- identifying an identifier (file name or program on the hard disk drive) associated with the media (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22);
- determining portions of the hard disk drive that are associated with the identifier (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22) Additionally, file names stored in a file manager by name and folder/directory is inherent to a hard disk drive having file managing capabilities; and
- preventing access to portions of the hard disk drive that are not associated with the identifier. Game programs inherently contain executable instructions to open/close/use etc. various files stored in memory. Inherently, a game program is only going to request files called by the executable instructions and associated with the video game. Therefore,

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inherently, the video game would not access portions of the hard disk drive that are not associated with the game. Also, as previously discussed above, the hard disk drive (206) is partitioned for different kinds of data.

Although Smith et al. does not appear to explicitly disclose a hard disk drive having a user data region and an application region; a game console having a hard disk drive that is configured to store application data such that data associated with a first application is inaccessible to other applications; and preventing the video game from accessing portions of the hard disk drive that are not associated with the video game Microsoft®Windows98 teaches these features.

It would have been obvious at the time of applicant's invention to utilize the advance file management techniques taught in Microsoft®Windows98 in order to partition a hard disk drive into separate application regions and to make certain files inaccessible to other applications in the video game. One would be motivated to do such that game data from different video games would be placed in a particular location on a hard drive such that game data and application data would be stored on the hard disk drive in an organized manner (pp. 80-81 and 87-90).

5. Claims 26, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. 6,599,194) in view of Microsoft®Windows98 and further in view of Links 386CD Players Manual.

Smith et al. in view of Microsoft®Windows98 teaches to one having ordinary skill in the art that as discussed above regarding Claims 18, 20-25, 27-35, 57, 58, 60, d 69-71. However, the combination seems to lack explicitly disclosing everything except:

Regarding Claims 11 and 26:

- the non-removable hard disk drive is configured to store a list of recently used nicknames.



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Regarding Claims 32, 33, 36, and 38:

- retrieving a list of recently used nicknames associated with the video game installed on the game console.

Regarding Claims 39 and 40:

- allowing the user of the game console to create a new nickname.

Regarding Claim 41:

- automatically entering the selected nickname into a high score display.

Links 386CD Players Manual discloses golf video game played on a game console (personal computer) having a hard disk drive and memory. Links 386CD Players Manual, Smith et al., and Microsoft®Windows98 are analogous art because each relate to a game system/computer to play video games. Furthermore, Links 386CD Players Manual teaches:

Regarding Claims 11, 26, 32, 33, 36, 38, 39, and 40:

- retrieving, displaying, and allowing a user of the gaming system to select and/or create a nickname (player name) from/in the Player List Box (Page 19).

Regarding Claim 41:

- automatically entering the selected nickname into a high score display (score card) (Page 28).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Links 386CD Players Manual nickname feature in Smith et al. in view of Microsoft®Windows98. One would be motivated to do so because this is an easy and fun way to distinguish (via an identifier) between each player's game data making the setup and creation of new and existing games simple to the game user.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-6, 8-18, 20-36, 38-42, 57-58, 60-67, and 69-71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,716,102. Although the conflicting claims are not identical, they are not patentably distinct from each other because to one having ordinary skill in the art at the time of applicant's invention, booting a computer into a graphical user interface upon powering up was notoriously well known.

### ***Response to Arguments***

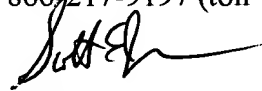
Applicant's arguments with respect to claims 18, 20-21, 22-35, 57-58, 60, and 69-71 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (571) 272-4438. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on (571) 272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Scott E. Jones  
Primary Examiner  
Art Unit 3714

SEJ